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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,761	10/11/2001	Kenneth C. Caster	IR-2588(ET)CIP2	1165

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EXAMINER
KNABLE, GEOFFREY L

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/975,761

Applicant(s)

CASTER ET AL.

Examiner

Geoffrey L. Knable

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-12, 14, 15, 17, 18 and 20-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-12, 14, 15, 17, 18 and 20-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1. Note: Applicant's petition for an unintentionally delayed benefit claim will be forwarded to the Office of Petitions for decision.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-5, 7-12, 14, 15, 17, 18 and 20-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 20 have been amended to define that the process of bonding is "without radiation, thermal or photochemical curing energy". Various dependent claims (10, 11, 21, 42) however define that the process or at least step (c) occurs at room temperature or ambient. Thus, if these claims are considered to further limit, then it is not entirely clear what the scope of the requirement for "without ..thermal..curing energy" is actually defining or requiring. An ambiguity in the scope of all the claims is therefore presented.

4. Claims 20-22, 41 and 42 are rejected under 35 U.S.C. 102(e) as being anticipated by Tokas et al. (US 2002/0053379) as applied in the last office action.

As to the newly claimed feature, note paragraph [0064]. With respect to the declaration under 1.130, as noted in MPEP 718, "A U.S. patent or U.S. patent application publication that anticipates the claimed subject matter cannot be disqualified as prior art under 35 U.S.C. 103(c) or 37 CFR 1.130 or 1.131."

5. Claims 1-5, 7-12, 14, 15, 17, 18 and 20-43 are rejected under 35 U.S.C. 103(a) as being obvious over Tokas et al. (US 2002/0053379) taken in view of Grubbs et al.

(US 5,728,785), Suzuki et al. (US 5,137,785) and Mühlebach et al. (US 5,973,085) as applied in the last office action.

With respect to the 9-30-2004 declaration under 1.130, when specifically referring to the "inventor" of the application (item (3) on page 2 of the declaration), reference is only made to one of the co-inventors as "the inventor" and as such, this would not seem to be a sufficient declaration. It is additionally noted that at least with respect to the 35 USC 103 rejections, another alternative to a 1.130 declaration is, as noted in the last office action: "For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2)."

6. Applicant's arguments filed 9-30-2004 have been fully considered but they are not persuasive with respect to the rejections based upon Tokas et al. (US 2002/0053379) for the reasons noted above.

Additionally, it should be noted that a divisional application (09/711,692) of the application that this '379 publication represents, has been filed, this divisional in particular being directed to and claiming the bonding embodiment and therefore presenting potential obviousness double patenting issues (if issued) for the same reasons advanced with respect to Tokas et al. (US 2002/0053379) in the last office action. Although any provisional 102(e) or 103/102(e) rejections over this application should stand or fall with the rejections above over the parent Tokas et al. (US

2002/0053379), insofar as this application (09/711,692) *claims* the bonding embodiment in a manner that would conflict with the present claims for the reasons already noted, obviousness double patenting issues are raised. Further, although a terminal disclaimer over 09/209706 was filed and has been accepted, it would not appear that this terminal disclaimer would apply to the divisional application 09/711,692. To avoid overcomplicating this action, these obviousness double patenting rejections have not been made but applicant should assure that any response addresses these potential issues (e.g. by filing a terminal disclaimer over 09/711,692).

As to the remaining prior art rejections set forth in the last office action, these have been withdrawn for the reasons given by applicant in the remarks accompanying the 9-30-2004 amendment, it being additionally noted that in addition to not being specifically directed to the same chemistry as presently claimed, Lesser, Cole et al. and Kriebel are directed to catalyzed coatings rather than bonding substrates together as now claimed.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the


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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 571-272-1220. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on 571-272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Geoffrey L. Knable
Primary Examiner
Art Unit 1733

G. Knable
December 12, 2004